

Attorney Docket No. ARC 2958 R1

REMARKS

The Final Office Action mailed June 2, 2003 (hereinafter the Office Action), has been received and reviewed. Claims 9 through 14 and 16 through 19 are finally rejected in the Office Action. Claims 10 through 14, however, are cancelled herein without prejudice or disclaimer, and Applicants have herein amended claim 9 and claims 16 through 19. Applicants respectfully request reconsideration of the application in light of the amendments and remarks set forth herein.

35 U.S.C. § 112 Rejections

Claims 9 through 14 and 16 through 19 are rejected under 35 U.S.C. § 112, second paragraph. The rejections contained in the Office Action are specifically drawn to claim 9 and claims 11 through 14. As claims 11 through 14 are cancelled herein without prejudice or disclaimer, Applicants respectfully request that the rejections of claims 11 through 14 under Section 112 be withdrawn. Regarding claim 9, Applicants respectfully submit that claim 9 meets the requirements of 35 U.S.C. § 112, second paragraph, and respectfully request that the rejection of claim 9 under Section 112 be withdrawn.

35 U.S.C. § 102 Rejections

Claims 9 through 14 and 16 through 19 stand rejected under Section 102(b) or Section 102(e) as being anticipated by Blose et al. (U.S. 3,663,278), Depoorter (U.S. 3,853,563), Hochberg et al. (U.S. 3,929,693), Matsumoto et al. (U.S. 4,256,492), Cope (U.S. 4,638,022), Whitbourne (U.S. 5,331,027), Socci et al. (U.S. 5,977, 217) or Schwark et al. (U.S. 6,429,248 B2). However, as already noted, claims 10 through 14 have been cancelled without prejudice or disclaimer, and as a result, the rejection of claims 9 through 14 and 16 through 19 under Section 102 is addressed herein only to the extent that it applies to claim 9 and claims 16 through 19.

Applicants respectfully submit that the references cited in the Office Action do not anticipate claim 9 or claims 16 through 19. In order for a reference to anticipate a claim under Section 102(b) that reference must expressly or inherently set forth each and every element

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recited in the claim. *Verdegaal Brothers v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Applicants respectfully submit that none of the references cited in the Office Action teaches or shows the semipermeable membranes recited claim 9 and claims 16 through 19 in as complete detail as is provided in the claims. In particular, Applicants respectfully submit that none of the references cited in the Office Action teaches a semipermeable membrane that is formed of the constituents recited in the rejected claims, wherein the constituents are formulated to provide a semipermeable membrane exhibiting a water transmission rate of between 1-60 cc·ml/cm²·hr. Therefore, Applicants further submit that the references cited in the Office Action do not anticipate claim 9 or claims 16 through 19 under Section 102, and Applicants respectfully request that the rejection of these claims under Section 102 be withdrawn.

35 U.S.C. § 103(a) Obviousness Rejections

Claims 9 through 14 and 16 through 19 alternatively stand rejected under 35 U.S.C. § 103(a) ("Section 103") as being unpatentable over Blose et al. (U.S. 3,663,278), Depoorter (U.S. 3,853,563), Hochberg et al. (U.S. 3,929,693), Matsumoto et al. (U.S. 4,256,492), Copc (U.S. 4,638,022), Whitbourne (U.S. 5,331,027), Socci et al. (U.S. 5,977, 217) or Schwark et al. (U.S. 6,429,248 B2). Again, however, claims 10 through 14 have been cancelled without prejudice or disclaimer, and as a result, the rejection of claims 9 through 14 and 16 through 19 under Section 103 is addressed herein only to the extent that it applies to claims 9 and claims 16 through 19.

Applicants respectfully request that the rejection of claim 9 and claims 16 through 19 under Section 103 be withdrawn. A rejection under Section 103(a) is improper and will be overturned unless a *prima facie* case of obviousness is established against the rejected claims. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). In this instance, Applicants respectfully submit that the references cited in the Office Action, whether taken alone or in combination, fail to provide evidence sufficient to properly establish the *prima facie* obviousness of any of the pending claims. Therefore, Applicants respectfully submit that the

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references cited in the Office Action do not support a rejection of claim 9 or claims 16 through 19 under Section 103.

As is set forth in M.P.E.P. 706.02(j), a *prima facie* case of obviousness under Section 103 can not be established unless three criteria are met:

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

It is the examiner that bears the burden of establishing these three criteria through the application of objective teachings or common knowledge possessed by those of ordinary skill in the art. *See, M.P.E.P.* § 2142.

In this case, Applicants respectfully submit that the teachings provided by the references cited in the Office Action fail to teach or suggest each of the limitations recited in the rejected claims. In particular, each of claims 9 and 16 through 19 recite a semipermeable membranes having constituents that are formulated to provide a semipermeable membrane exhibiting a water transmission rate of between 1-60 cc/ml/cm²·hr. Yet the references cited in the Office Action, whether taken alone or in combination, do not teach or suggest a semipermeable membrane that is formed of the constituents recited in the rejected claims, wherein the constituents are formulated to provide a semipermeable membrane exhibiting a water transmission rate of between 1-60 cc/ml/cm²·hr. Applicants, therefore, respectfully submit that the references cited in the Office Action do not establish all of the criteria necessary to support the *prima facie* obviousness of the rejected claims, and Applicants respectfully request that the rejection of claims 9 and 16 through 19 under Section 103 be withdrawn.

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CONCLUSION

Claims 9 and 16 through 19 are believed to be in condition for allowance, and a notice thereof is respectfully solicited. Should the Examiner determine that additional issues remain which might be resolved by a telephone conference, she is respectfully invited to contact Applicants' undersigned attorney.

Respectfully Submitted,



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Date: December 2, 2003